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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,385	01/22/2002	Alexandre Rado	1006-02	5902

35811 7590 07/27/2004

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EXAMINER

WORJLOH, JALATEE

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/054,385

Applicant(s)

RADO, ALEXANDRE

Examiner

Jalatee Worjloh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/24/2004 has been entered.

Response to Arguments

2. Applicant's arguments filed 05/24/2004 have been fully considered but they are not persuasive.

Claim 1:

Applicant argues that Leonard does not teach "additional series of boxes that designate the type of currency of payment".

In response to applicant's arguments, the recitation "an electronic payment card having a series of boxes for designation of the type of currency of payment" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness

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but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 6 is rejected as being a single means claim.

A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In *re Hyatt*, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to *Hyatt* is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over FR 2747962 to Ittah (see Translation of French Patent) in view of US Patent No. 4958066 to Hedgcoth.

Referring to claim 1, Ittah selecting a monetary amount for the electronic payment card, removing selected portions of the masking device by selecting a number of units in corresponding to the boxes to enable the selected monetary amount; and communicating codes corresponding to the boxes whose masking device has been removed by the payer to a transaction receiving center (i.e. "information processing center") for monetary payment verification (see pg. 1, lines 1-5; pg. 2, lines 4-12; pg. 5, lines 3-5; see Figure 1). Ittah does not expressly disclose a multiplicity of series of 10 boxes numbered from 0 to 9. Hedgcoth discloses a multiplicity of series of 10 boxes numbered from 0 to 9 (see fig. 1, reference characters 2 & 11; col. 3, lines 59-62). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the payment card disclose by Ittah to include a multiplicity of series of 10 boxes numbered from 0 to 9. One of ordinary skill in the art would have been motivated to do this because it provides security by allowing the cardholder to utilize multiple codes for different transactions.

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Referring to claim 2, Ittah discloses the card further comprises a zone having a series of numbered boxes for designation of a number of uncovered payment boxes (see pg. 2, lines 13-14, see Figure1, ref. character (4)).

Referring to claim 3, Ittah discloses the card has a unique identification number (see pg. 3, lines 8-9, 18-19; pg. 4, lines 1-3).

Referring to claim 4, Ittah discloses the process wherein payment is implemented by communication of codes corresponding to boxes whose masking device were removed by the payer and a personal identification number of the payer (see pg. 3, lines 18-19; pg. 4, lines 1-3).

6. Claims 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ittah, Hedgcoth and US Patent NO. 5945652 to Ohki et al.

Referring to claim 7, Ittah discloses an electronic payment card having boxes having a unique code and a mask which hides the unique codes, at least selected portions of the mask corresponding to selected boxes being removable to reveal a unique code corresponding to each box such that when selected portions of the mask are removed by a user to represent a selected numerical payment value, a third party (i.e. "center for information processing"), in possession of corresponding verification codes for the unique codes of the selected boxes, can verify the selected payment value (see pg. 1, lines 1-5; pg. 2, lines 6-10; pg. 5, lines 3-5; see Figure 1). Ittah does not expressly disclose a support having a series of boxes for designation of the type of currency of payment and a multiplicity of series of 10 boxes numbered from 0 to 9, said series corresponding to base units and multiples thereof of undefined payment value. Hedgcoth discloses a support having a multiplicity of series of 10 boxes numbered from 0 to 9, said series corresponding to base units and multiples thereof of undefined payment value (see fig. 1,

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reference characters 2 & 11; col. 3, lines 59-62). As for the a support having a series of boxes for designation of the type of currency of payment, Ohki et al. teach an e-wallet including a display, operation key and body (see fig. 3a), when a user's IC card (i.e. "electronic payment card") is housed in the e-wallet, the user can select multiple tasks using a function key (see fig. 8). For example, the "user's depression of the function key F causes an icon indicative of one of the aforementioned tasks S, T, L, ST and M in a first function level layer 3502 lower by one than the function key F to appear on the liquid crystal display part 312" (see col. 11, lines 39-43). Additionally, "when the user selects the task M in the first function level layer 3502 and pushes the enter key E, **he can select the task CU or CA** in the second function level layer 3503. **The task CU having a currency exchange function, when the IC card 10 stores therein different country currencies, is used to select one of the currencies**" (see col. 12, lines 1-6). Although the physical boxes are not display on the card's surface, the process of the allowing the user to designate the type of currency is taught; therefore, the examiner notes that modifying the electronic card of Ohki et al. to include boxes for designating the currency type on the surface is obvious. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the payment card disclose by Ittah to include a support having a multiplicity of series of 10 boxes numbered from 0 to 9 and a series of boxes for designation of the type of currency. One of ordinary skill in the art would have been motivated to do this because it provides security by allowing the cardholder to utilize multiple codes for different transactions.

Referring to claim 8, Ittah discloses the payment card further comprising group of boxes corresponding to each of said series of boxes (see fig. 1, (4)).

Referring to claim 9, Ittah discloses a payment card having unique codes (see claim 7 above). Although, Ittah does not explicitly teach three character alphanumeric codes, the examiner notes that the code may be any length (1,2,3...n) without departing from the scope of Ittah's invention.

Referring to claim 11, Ittah discloses a secure electronic payment card comprising a support having unique code; and a mask which hides the codes, at least selected portions of the mask corresponding to selected boxes being removable to reveal a unique code corresponding to each box such that when selected portions of the masks are removed by a user to represent any selected numerical payment value, a third party (i.e. "center for information processing"), in possession of corresponding verification codes for the unique codes of the selected boxes, can verify the selected payment value, a transaction center (i.e. "center for information processing") containing said verification codes which verifies the authenticity and coherence of the selected payment value (see pg. 1, lines 1-5, pg. 2, lines 6-10; pg. 5, lines 3-5; see Figure 1). Ittah does not expressly disclose a support having a series of boxes for designation of the type of currency of payment and a multiplicity of series of 10 boxes numbered from 0 to 9, said series corresponding to base units and multiples thereof of an undefined payment value. Hedgcoth discloses a support having a multiplicity of series of 10 boxes numbered from 0 to 9, said series corresponding to base units and multiples thereof of undefined payment value (see fig. 1, reference characters 2 & 11; col. 3, lines 59-62). As for the a support having a series of boxes for designation of the type of currency of payment, Ohki et al. teach an e-wallet including a display, operation key and body (see fig. 3a), when a user's IC card (i.e. "electronic payment card") is housed in the e-wallet, the user can select multiple tasks using a function key (see fig. 8). For

example, the "user's depression of the function key F causes an icon indicative of one of the aforementioned tasks S, T, L, ST and M in a first function level layer 3502 lower by one than the function key F to appear on the liquid crystal display part 312" (see col. 11, lines 39-43).

Additionally, "when the user selects the task M in the first function level layer 3502 and pushes the enter key E, **he can select the task CU or CA** in the second function level layer 3503. **The task CU having a currency exchange function, when the IC card 10 stores therein different country currencies, is used to select one of the currencies**" (see col. 12, lines 1-6). Although the physical boxes are not display on the card's surface, the process of the allowing the user to designate the type of currency is taught; therefore, the examiner notes that modifying the electronic card of Ohki et al. to include boxes for designating the currency type on the surface is obvious. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the payment card disclose by Ittah to include a support having a multiplicity of series of 10 boxes numbered from 0 to 9, said series corresponding to base units and multiples thereof. One of ordinary skill in the art would have been motivated to do this because it provides security by allowing the cardholder to utilize multiple codes for different transactions.

7. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ittah and Hedgcoth and Ohki et al. as applied to claim 7 above, and further in view of Leonard et al.

Ittah discloses the payment card having a series of boxes (claim 7 above). Ittah does not expressly disclose the payment card having the multiples selected from the group consisting of hundredths, tenths, tens, hundreds, thousands and tens of thousands. Leonard et al. disclose

payment card having the multiples selected from the group consisting of hundredths, tenths, tens, hundreds, thousands and tens of thousands (see Abstract, lines 1-5; fig. 1, ref. Character (40)).

Note. Leonard et al. disclose these features for a bank check or like instrument; thus, these features can be used for a payment card. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the payment card disclose by Ittah to include multiples selected from the group consisting of hundredths, tenths, tens, hundreds, thousands and tens of thousands. One of ordinary skill in the art would have been motivated to do this because it provides a clear presentation to the cardholder.

8. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ittah, Hedgcoth and Ohki et al. as applied to claim 11 above, and further in view of US Pub. No. 2002/0120587 to D'Agostino.

Ittah discloses a transaction center containing said verification codes, which verifies the authenticity and coherence of the selected payment value (see pg. 5, lines 3-5). Ittah does not expressly disclose the transaction center debits payments for a user of the card, or communicates with a merchant to verify a successful payment. D'Agostino discloses the transaction center debits payments for a user of the card, or communicates with a merchant to verify a successful payment (see paragraphs [012], lines 10-19; [013], [014]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Ittah to include the transaction center debits payments for a user of the card, or communicates with a merchant to verify a successful payment. One of ordinary skill in the art would have been motivated to do this because it ensures that the merchant receives a payment for the service provided.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 703-305-0057. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306, 703-746-9443 for Non-Official/Draft.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
PO Box 1450
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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, V.A., Seventh floor receptionist.

July 23, 2004


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